

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

AF
GP1731

In re Patent Application of

HENRICSON et al

Serial No. 08/875,424

Filed: July 28, 1997

Title: METHOD OF PRETREATING PULP TO BE
BLEACHED WITH PEROXIDE



Atty. Dkt.: 30-440
C# M#

Group Art Unit: 1731

Examiner: Alvo

Date: April 20, 2000

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Honorable Commissioner for Patents and Trademarks
Washington, DC 20231

Sir:

☐ **NOTICE OF APPEAL**

Applicant hereby appeals to the Board of Appeals from the decision dated _____ of the Examiner twice/finally
rejecting claims _____ (\$ 300.00)

\$ 0.00

☐ An appeal **BRIEF** is attached in triplicate in the pending appeal of the
above-identified application (\$ 300.00)

\$ 0.00

☐ An **ORAL HEARING** is requested under Rule 194 (\$ 260.00)
(due within two months after Examiner's Answer)

\$ 0.00

☐ Credit for fees paid in prior appeal without decision on merits

-\$ (0.00)

☒ A reply brief is attached in triplicate under Rule 193(b)

(no f e)

☐ Petition is hereby made to extend the current due date so as to cover the filing date of this
paper and attachment(s) (\$110.00/1 month; \$380.00/2 months; \$870.00/3 months; \$1360.00/4 months)

\$ 0.00

SUBTOTAL \$ 0.00

☐ Applicant is a "small entity"; enter 1/2 of subtotal and subtract
☐ "small entity" statement attached

-\$ (0.00)

SUBTOTAL \$ 0.00

Less month extension previously paid on

-\$ (0.00)

TOTAL FEE ENCLOSED \$ 0.00

Any future submission requiring an extension of time is hereby stated to include a petition for such time extension.
The Commissioner is hereby authorized to charge any deficiency in the fee(s) filed, or asserted to be filed, or which
should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our **Account No. 14-1140**. A duplicate copy of this sheet is attached.

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By Atty.: Robert A. Vanderhye, Reg. No. 27,076

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#181(3053)

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Serial No. 08/875,424

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REPLY BRIEF

Sir:

This reply is filed to the Examiner's Answer of March 2, 2000.

In section (13) on page 5 of the Examiner's Answer it is alleged that appellants allege that Devyns et al do not teach acid pretreatment. If what is meant by this is that appellants have argued that Devyns et al do not teach a bleaching sequence in which a Q-stage is preceded by an A-washing stage (which is what is relevant as far as the claimed invention is concerned), then this statement is correct. However, what is incorrect is the allegation later on in the same paragraph of the Examiner's Answer that in fact Devyns et al teach something relevant to the claimed invention in this regard.

It is respectfully submitted that Devyns et al are being evaluated in the Examiner's Answer on the basis of what they teach in view of the 20-20 hindsight knowledge of the present invention. There is no way that one of ordinary skill in the art viewing Devyns et al without the benefit of the invention would notice any similarity

between what is in Devyns et al and the invention of claim 16. Claim 16 calls for the specific acid pretreatment set forth therein at a particular pH, pressure, and like conditions, then transferring the pulp from an acid tower to the tower of a second treatment stage, and then in the second treatment stage tower treating the pulp with a complexing agent. Then only after washing, pressing, or both washing and pressing, the pulp is treated with hydrogen peroxide. Contrary to this, page 4, line 28 of the translation of Devyns et al says that the Q-stage can -- as a variation -- consist of a treatment with acid "without a sequestrant". This specifically teaches against using an acid stage as specified in claim 16, followed by a sequestration stage. Rather, what this teaches is that you would have either one stage or the other, but not both, and certainly not in towers and in the manner recited in claim 16. Also, see the translation starting just after page 5, line 4 when it talks about "When no sequestrant is present in the Q-stage" but the pH is different, not that they would ever be provided consecutively.

Also, the temperature in the Q-stage of Devyns et al is desired to be about 50-60° (see the translation after page 5, line 4). While it says that the temperature could be higher than that it is not desirable to exceed 100°C, and preferably it does not exceed 90°C. That also contraindicates the invention where the temperature is -- in the acid stage -- always higher than the preferred temperature than 60°C according to Devyns et al.

Thus, when Devyns et al are evaluated for what they really teach one of ordinary skill in the art, rather than what is simply convenient for a rejection, it will be apparent that Devyns et al do not teach the invention. In this regard see *In re Kamm*, 172 USPQ 298, 301, 302 (CCPA 1972) wherein the Court held:

"The rejection here runs afoul of a basis mandate inherent in §103 -- that 'a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure' shall not be the basis for a holding of obviousness. In *re Rothermel*, 47 CCPA 866, 870, 276 F.2d 393, 396, 125 USPQ 328, 331 (1960). 'It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.' ... However, we are satisfied that when the secondary references are viewed in their entirety, with due consideration given to what they fail to disclose and what they disclose as undesirable, it is evident that the proposed modification of the primary reference would not have been obvious to one of ordinary skill in the art at the time the invention was made." (Emphasis added.)

With respect to the arguments regarding the EP '491 reference, primarily on page 6 of the previous Action, the temperature and other ranges within the EP '491 reference are so broad as to be virtually meaningless. The situation here is much like it or as in *In re Luvisi*, 144 USPQ 646, 650 (CCPA 1965) wherein the court held:

"But an expression which includes numerous species does not, necessarily, ipso facto 'disclose' each and every one of those species. As so aptly stated by appellants, 'It is possible for a patent to include a wide variety of subject matter but at the same time not to disclose a particular subject matter.' (Emphasis ours.) We might add that the reference need not be a patent. Our approach to this question is to ask whether or not it can fairly and reasonably be said that one of ordinary skill in the art through a reading of the entire reference has constructive possession of the thing itself, as opposed to possession of mere language which embraces the name of that thing."

Considering the grossly broad and general disclosure in the EP '491 reference, when evaluating what that reference teaches one of ordinary skill in the art (which is what is what is important in determining whether or not there is a proper *prima facie* case of obviousness), one should look specifically at what the detailed teachings of the

'491 reference are. Such detailed teaching is provided in the examples. The first five examples teach a washing step between the acid and the chelating steps. These examples teach a temperature of 50°C in the A-stage. Example 6 teaches the use of a temperature 50°C in the A-stage, with the chelating performed at the same temperature. Thus, in all of the examples provided in the '491 reference, the temperature taught is much lower than that according to the present invention, and the mere general indication within the specification that the temperature can be up to 100°C does not provide the necessary teaching to one of ordinary skill in the art to specifically modify the Devyns et al reference (where also the preferred temperature in the sequestering stage is around 50-60°C) and instead provide the invention. Again, the entire disclosures of the references must be viewed, not merely portions thereof convenient to a rejection. See *In re Kamm, supra*.

It is apparently suggested in the Examiner's Answer that the invention, particularly in specifically calling for decreasing the kappa number by 1 to 9 units during acid treatment, is inherent in the EPO '491 reference. This is not so. Inherency requires certainty not mere probability. See *In re Robertson*, 49 USPQ2d 1949, 1950, 1951 (Fed. Cir. 1999) wherein the Court held:

"If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is 'inherent' in its disclosure. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' *Continental Can Co. v Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). 'Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' *Id.* at 1269, 20 USPQ2d at

1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

In finding anticipation by inherency, the Board ignored the foregoing critical principles. The Board made no attempt to show that the fastening mechanisms of Wilson that were used to attach the diaper to the wearer also 'necessarily' disclosed the third separate fastening mechanism of claim 76 used to close the diaper for disposal, or that an artisan of ordinary skill would so recognize. It cited no extrinsic evidence so indicating. ...

Indeed, the Board's analysis rests upon the very kind of probability or possibility -- the odd use of fasteners with other than their mates -- that this court has pointed out is insufficient to establish inherency."

In this case, the EPO '491 reference specifically treats the pulp in all of the examples thereof in the A-stage at a maximum temperature of 50°C. This is 25°C below the minimum temperature set forth in step (c) of claim 16. It is completely impermissible to suggest that with a difference in temperature of this magnitude (temperatures one and one-half times the temperature in the '491 reference) that one should expect the same results, also considering the pressures and time set forth in step (c), the pH, etc., all of which are balanced to get the desired kappa number reduction. Therefore, it is a matter of sheer speculation and surmise that the EPO '491 reference will have the same reduction in kappa number as is achieved according to the invention. The Federal Circuit and the CCPA have condemned surmise, speculation, and conjecture by the Patent and Trademark Office in every context in which they have arisen. See *In re Katzschnmann*, 347 F.2d 620, 146 USPQ 66 (CCPA 1965), *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (CCPA 1971), and *In re Gardner*, 475 F.2d 1589, 177 USPQ 396 (CCPA 1973).

The deficiencies of Devyns et al and the EPO '491 reference cannot be remedied by application of Marechal. Marechal specifically teaches an independent acid stage. Marechal does not suggest that the acid stage could be combined with a chelating stage, or a dioxide stage. Nor does the EPO '491 reference provide any suggestion whatsoever as to any reason why it would use the A-stage to reduce the kappa number of the pulp. Without any suggestion whatsoever for any reason to do this there can be no *prima facie* case of obviousness. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598, 1599 (Fed. Cir. 1988).

Further, there simply and unequivocally is no *prima facie* case of obviousness considering the diverse teachings of Devyns et al, EP '491 and Marechal. The Devyns et al and EP '491 references use an acid stage for metal removal at various portions thereof, while Marechal does not even mention the possibility of using his acid stage for metal removal. Again it is only with the benefit of 20-20 hindsight considering the invention, and what the invention teaches to those in the art, that any modification of the references to provide the invention is provided, but it is impermissible to use appellants' teachings against them in this regard. *In re Ruff*, 118 USPQ 340, 347 (CCPA 1958).

Thus, claim 16, and all the claims dependent therefrom, clearly patentably distinguish from the art.

The Examiner's Answer still does not provide any analysis whatsoever of the dependent claims, therefore what is set forth in the main brief is just as applicable now as then. The only exception to this is claim 19, which is discussed in the first full paragraph on page 8. However, this analysis is shallow especially when it is considered that Marechal specifically provides non-chlorine bleaching and specifically excludes the

use of dioxide, and therefore provides a negative teaching for what is set forth in claim 19. Again, as pointed out in the main brief, this analysis of claim 19 ignores the fact that claim 19 specifically calls for using chlorine dioxide prior to or in combination with the complexing agent, whereas there is absolutely no reason why such an arrangement would be provided in the primary reference of Devyns et al, and in fact there is a negative teaching therefor.

With respect to the other dependent claims, the penultimate paragraph on page 8 of the Examiner's Answer takes the wrong approach. Appellants have specifically and correctly pointed out that the prior art does not teach the recitations in these dependent claims, nor any reason why what is set forth in the claims should be provided. The Examiner's Answer continues to ignore -- as did the Final Rejection -- that it is the burden on the Patent & Trademark Office to provide a *prima facie* case of obviousness. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). Appellants cannot argue against themselves. Until the Patent & Trademark Office establishes a *prima facie* case of obviousness for the limitations of these claims, appellants need do no more than to correctly -- as has been done here -- point out that the references do not teach what is recited in the dependent claims even if combined, and that there is no reason why the references would be combined in view of the prior art.

The standard applied in the rejection of claim 35 in the last paragraph on page 7 of the Examiner's Answer is completely erroneous. Appellants do not have the burden of proving unexpected results in order for there to be unobviousness. See *Kansas Jack v. Kuhn*, 219 USPQ 857, 860 (Fed. Cir. 1983) wherein the court held:

Facts determinable at a later time may serve to evidence nonobviousness as of the time the invention was made. An

invention that did achieve 'an effect greater' or that produced 'unusual or surprising results' could of course be held to have been nonobvious in light of those facts. Evidence of such achievements, like evidence of meeting a long-felt need, commercial success, overcoming disbelief, etc., may when present support a conclusion of nonobviousness. *Stratoflex, Inc. v Aeroquip Corp.*, No. 83-587, slip op. at 22. 218 USPQ at 871 (Fed. Cir. July 25, 1953). Absence of such evidence, on the other hand does not dictate a conclusion of obviousness."

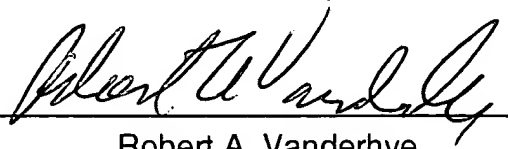
Also, regarding claim 35, it is sheer speculation for the Patent & Trademark Office to allege that the same results are achieved according to the prior art as according to the invention, or that there would be any reason why one of ordinary skill in the art would in any way consult the Japanese reference or Walsh when attempting to achieve the desired goals of the invention. Therefore, there simply is no *prima facie* case of obviousness.

The Examiner's Answer again does not even address claims 36 through 46 in any detail. Rather, they are simply grouped together with claim 16, and many claims dependent thereon, in making a general shotgun rejection. Therefore, it is clear that the arguments with respect to claims 36 through 46 in the main brief are not refuted, and irrefutable.

In conclusion early reversal of the Final Rejection and passage of the subject application are earnestly solicited.

Respectfully submitted,

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